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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/243,016	02/02/1999	DIRK LENZ	BEIERSDORF54	1839

7590 06/18/2003

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EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 06/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/243,016

Applicant(s)

Lenz et al.

Examiner

Isis Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 3, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3, and 5-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 5-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

The receipt is acknowledged of applicants' request for reconsideration, filed 04/03/2003.

**The pending claims are 1, 3, 5-13.**

**1. The standing rejection:**

Claims 1, 3, 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 89/04649 ('649), by itself or in combination with US 3,908,645 ('645).

WO '649 discloses an occlusive opaque eye patch comprising:

- 1) an outer polymeric foam layer,
- 2) intermediate foam layer,
- 3) inner pressure sensitive adhesive layer, and
- 4) inner member of black felt which is dimensioned so that it can be placed concentrically within the edges of the adhesive layer so that peripheral portion of the adhesive is exposed to be attached to the skin. The adhesive portion is secured with a cover that can be peeled off at use. See page 1, lines 3-6; page 5, lines 1-12, 23-30; page 6, lines 1-3; page 9, lines 12-17.

WO '649 does not disclose the foam material as polyurethane or the method of making the foam.

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US '645 discloses an eye bandage comprising a layer of polyurethane foam, covered with non-woven web material of polyester on one side and pressure sensitive adhesive layer on the other side. The pressure sensitive adhesive is covered with a release liner. The reference disclosed foaming the polyurethane between two liners and the foam is then split or slit through its center producing two identical thinner sheets of foam having minimum reflectance (opaque). See abstract; col.1, lines 44-58; col.2, lines 30-43; col.3, lines 31-44; col.4, lines 3-4, 35-50; col.6, lines 9-16.

Applicants failed to show criticality or superior and unexpected results in the sequence of arranging the layers or having the three layers made of foam. Felt is also a kind of foam, is not solid or compact.

Accordingly, it would have been obvious for one having ordinary skill in the art at the time of the invention to produce an occlusive patch consisting of three layers of foam material, and use the polyurethane of US '645, motivated by the teaching of US '645 that the two layers of foam provide very low reflectance, with reasonable expectation of success of the delivered patch as an ophthalmic light occlusive patch.

## **2. Applicants' argument:**

The main gist of applicants' argument against the 103 rejection is that the references do not teach third foam layer.

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**3. Examiner's position:**

In response to the above argument, the examiner position is that: WO '649 teaches clearly 2 foam layers and felt black layer (page 9, lines 10-17). Applicants failed to provide superior and unexpected results to show the criticality in having the three layers made of foamed material. US '645 disclosed two layers of foam and is relied upon for teaching the foam as polyurethane. The conclusion of obviousness under U.S.C. 103(a) does not require absolute predictability, only a reasonable expectation of success, and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. The art recognized the use of foamed layers in the eye patch and the effectiveness of having more than one foamed layers in the eye patch regarding its resiliency and light reflection, as well as absorbency and this would have motivate one having ordinary skill in the art to select any other layers in the eye patch to be foamed to add more comfortability to the patient. Thus, one having ordinary skill in the art at the time of the invention would have been motivated to produce an occlusive patch consisting of three layers of foam material, and use the polyurethane of US '645, motivated by the teaching of US '645 that the two layers of foam provide very low reflectance, with reasonable expectation of success of the delivered patch as an ophthalmic light occlusive patch.

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***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Isis Ghali whose telephone number is (703) 305-4048. The examiner can normally be reached on Monday-Friday from 7:00 to 5:30 Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Isis Ghali

Patent Examiner

THURMAN K. PAGE  
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